

Exhibit E



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,844	08/03/2001	Gary K. Michelson	101.0084-01000	8295
22882	7590	01/07/2004		
MARTIN & FERRARO, LLP 1557 LAKE O'PINES STREET, NE HARTVILLE, OH 44632				
			EXAMINER SNOW, BRUCE EDWARD	
			ART UNIT 3738	PAPER NUMBER

DATE MAILED: 01/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

JAN 12 2004

MARTIN & FERRARO LLP

LOCKETED BY: Yhm
 ON: 1-13-04
 ACTION
 REQUIRED: resp/rel.
 DATE
 REQUIRED: 4-7-04

4-7-04

Office Action Summary	Application No.	Applicant(s)	
	09/921,844	MICHELSON, GARY K.	
	Examiner	Art Unit	
	Bruce E Snow	3738	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 131, 133, 135, 137-145, 205, 206 and 213-215 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 3, 5, 19-42, 44-56 and 259-271 is/are allowed.
- 6) ☒ Claim(s) 43, 219, 228-255 and 277-284 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/9/03 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-1448)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Continuation Sheet (PTOL-326)

Application No. 09/921,844

Continuation of Disposition of Claims: Claims pending in the application are 1,3,5,19-56,131,133,135,137-145,203-209,213-215,228-255 and 258-284.

Application/Control Number: 09/921,844
Art Unit: 3738

Page 2

DETAILED ACTION

In response to this office action, the Examiner requests all new proposed drawings and drawing limitations submitted in Amendment D and hereafter are resubmitted and shown in red.

Election/Restrictions

Claims 131, 133, 135, 137-145, 205, 206, 213-215, and 272-276 (all claims depending from 131) are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species. Applicant timely traversed the restriction (election) requirement in Paper No. 6.

Regarding claim 131, the elected embodiment shown in figures 12-15 has left and right facets that are identical, the left facet is not steeper than the right facet. Further note that the last line added to the claim, "*said first and second surface projections having at least one facet with the perimeter..*" is not understood.

This application contains claims drawn to an invention nonelected with traverse in Paper No. 6. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Response to Arguments

Applicant's arguments filed 10/9/03 have been fully considered but they are not persuasive.

Regarding the rejection of claim 219 in view Aebi et al, applicant states that all facets have included angles of 90 degrees or less which is not persuasive because claim 219 fails to specify how the angles are being measured; are the facet angles

Application/Control Number: 09/921,844
Art Unit: 3738

Page 3

being measured from the front, back, etc? All claim limitations are given their broadest interpretation. It is the Examiner's instinct to measure the rearward facet of Aebi et al from the rear relative the base producing an angle greater than 90 degrees.

Specification

The amendment filed 10/9/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The following proposed drawings and associated descriptions added to the specification is considered new matter.

Figures 1A and 1B are new matter. These figures show a completely new spinal implant embodiment in which one having ordinary skill in the art reading the original claims (of 09/457,228) would not have conceived. It is noted that the embodiment was incorporated from U.S. Patent No. 5,593,409, however that drawing does not show the current projections. The combination of the current invention surface projections and previous embodiment is new matter. Note that proposed Figure 1A shows the surface projects at an angle relative the leading and trailing ends which is new matter.

Figure 1C is new matter. Original claim 45 says nothing about a motion preserving device. It is unclear what a motion preserving device is.

Figure 12A and 12B, what is the difference?

Figure 14A and 14B – it is mechanically impossible to have anything but a V-shape. Please confirm that claim 18 is original to 09/457,228.

Application/Control Number: 09/921,844
Art Unit: 3738

Page 4

Applicant is required to cancel the new matter in the reply to this Office Action.

Note that proposed drawing 14C is approved by the Examiner.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, all claims must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Due to the large number of claims only some specific claims will be addressed as examples purposes only. ***It is Applicant's responsibility to ensure all claimed limitations are shown in the drawings or to remove limitations or cancel the claims of the limitations not shown.***

Examples of claims not shown: Claim 21 – arcuate upper and lower surfaces; claim 22-24, Claim 47 – “cap”; 228-232, 269.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Application/Control Number: 09/921,844
Art Unit: 3738

Page 5

The following claims are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 43, 247, and repeats thereof, what is and how is the fusion implant a "motion preserving device"? Please cancel this claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 219, 228-255, 277-284 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aebi et al (6,482,233).

Aebi et al teaches a spinal implant comprising bone engaging structures that are generally pyramid-shaped formed on the upper and lower surfaces of the implant. The engaging structures are slanted towards the anterior therefore having a forward

Application/Control Number: 09/921,844
Art Unit: 3738

Page 6

(anterior) facing facet that is shorter than a rearward facing facet and said forward facing facet has a steeper slope; the structures further include side facets. Applicant claims the opposite Aebi et al claiming the bone engaging structures slant rearward (posteriorly). However, both Aebi et al and applicant teach the bone engaging structures slant in a direction such to allow ease of insertion and to avoid retropulsion. See Aebi et al column 4, lines 30-34 and applicant's specification page 5, lines 5-9 and lines 15-19. It would have been obvious to one having ordinary skill in the art to have slanted the bone engaging structures of Aebi et al posteriorly such that the implant could be introduced posterior-laterally and/or resist movement in the direction towards the spinal cord when a surgeon deems it necessary. Note that Aebi et al teaches the steeper angled face can be "from about 0 to 30 degrees" which the Examiner interprets to include negative angles.

Many of applicant's dependent claims claim a wide range of possibilities, for example, an angle can be less than 90 degrees, perpendicular, or greater than 90 degrees; the groove can be v-shaped, u-shaped, box-like shape; etc, lacking any criticality in the specification, the use of any claimed variation, range, or configuration in lieu of those used in the references solves no stated problem and produces no benefits and would have been an obvious matter of design choice for someone skilled in the art.

Additionally, many of the dependent claims claim elements/materials/shapes/tools/etc. which are taught by the reference or are well known in the prosthetic art and would have been obvious to one having ordinary skill.

Application/Control Number: 09/921,844
Art Unit: 3738

Page 7

Claims 219, 228-255, 277-284 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Paul et al (6,258,125).

Paul et al teaches a spinal implant comprising a plurality of surface projections on upper and lower surfaces. Said projections having a forward facet, rearward facet, and two side facets; wherein the forward facet is longer and rearward facet has a steeper slope and an angle greater than 90 degrees. See figures 9 and 10A which are interpreted as having said four facets.

In the alternative, under 35 U.S.C. 103(a): Many of applicant's dependent claims claim a wide range of possibilities, for example, an angle can be less than 90 degrees, perpendicular, or greater than 90 degrees; the groove can be v-shaped, u-shaped, box-like shape; etc, lacking any criticality in the specification, the use of any claimed variation, range, or configuration in lieu of those used in the references solves no stated problem and produces no benefits and would have been an obvious matter of design choice for someone skilled in the art.

Additionally, many of the dependent claims claim elements/materials/shapes/tools/etc. which are taught by the reference or are well known in the prosthetic art and would have been obvious to one having ordinary skill.

Claims 219, 228-255, 277-284 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fraser (6,432,106).

Application/Control Number: 09/921,844
Art Unit: 3738

Page 8

Fraser teaches a spinal implant comprising a plurality of surface projections on upper and lower surfaces. Referring to all figures, specifically figure 10, said projections having a forward facet, rearward facet, and two side facets; wherein the forward facet is longer and rearward facet is undercut and has a steeper slope and an angle greater than 90 degrees.

In the alternative, under 35 U.S.C. 103(a): Many of applicant's dependent claims claim a wide range of possibilities, for example, an angle can be less than 90 degrees, perpendicular, or greater than 90 degrees; the groove can be v-shaped, u-shaped, box-like shape; etc, lacking any criticality in the specification, the use of any claimed variation, range, or configuration in lieu of those used in the references solves no stated problem and produces no benefits and would have been an obvious matter of design choice for someone skilled in the art.

Additionally, many of the dependent claims claim elements/materials/shapes/tools/etc. which are taught by the reference or are well known in the prosthetic art and would have been obvious to one having ordinary skill.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

Application/Control Number: 09/921,844
Art Unit: 3738

Page 9

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E Snow whose telephone number is (703) 308-3255. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703)308-2111. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

bes

BRUCE SNOW
PRIMARY EXAMINER

Notice of References Cited	Application/Control No. 09/921,844	Applicant(s)/Patent Under Reexamination MICHELSON, GARY K.	
	Examiner Bruce E Snow	Art Unit 3738	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-6,432,106	08-2002	Fraser, Robert	606/61
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

U.S. Patent and Trademark Office
PTO-892 (Rev. 01-2001)

Notice of References Cited

Part of Paper No. 14

Exhibit F

BOX AF
RESPONSE UNDER 37 C.F.R. 1.116
EXPEDITED PROCEDURE
EXAMINING GROUP 3738

PATENT
Attorney Docket No. 101.0084-01000
Customer No. 22882

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	Confirmation No.: 8295
Gary K. Michelson)	
Serial No.: 09/921,844)	Group Art Unit: 3738
Filed: August 3, 2001)	Examiner: B. Snow
For: SPINAL IMPLANT SURFACE)	
CONFIGURATION)	

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REQUEST FOR RECONSIDERATION

In reply to the to the Final Office Action dated January 7, 2004, the following remarks are submitted:

Application No. 09/921,844
Request dated March 26, 2004
Reply to Office Action of January 7, 2004

REMARKS

In the Office Action, the Examiner withdrew claims 131, 133, 135, 137-145, 205, 206, 213-215, and 272-276 and made the entire action final. Applicant respectfully requests the Examiner to rejoin claims 131, 133, 135, 137-145, 205, 206, 213-215, and 272-276, and to withdraw finality of the last action.

I. Request for rejoinder of withdrawn claims

Applicant respectfully requests the Examiner to rejoin claims 131, 133, 135, 137-145, 205, 206, 213-215, and 272-276. The Restriction Requirement dated October 28, 2002 ("the Restriction Requirement") restricted the application into six patentably distinct species. Applicant elected Species 3, Fig. 12, directed to a surface projection having a "back cut," or an included angle greater than 90 degrees. For the Examiner's convenience, Applicant has attached hereto as Exhibit A a copy of Fig. 13 showing an included angle greater than 90 degrees hand circled and labeled. Applicant amended independent claim 131 to recite that the first and second surface projections each have "at least one facet with the perimeter of said at least one facet having at least a first and a second portion arranged to form an included angle greater than 90 degrees between said first and second portions of the perimeter." Accordingly, Applicant submits that claim 131 includes the main feature that caused the Examiner to restrict the subject matter illustrated in former Fig. 12.

The Examiner noted that in contrast to the subject matter of claim 131, the elected species of Figs. 12-15 showed left and right facets that were identical. (Office Action, page 2, second paragraph). An exemplary embodiment of claim 131 is illustrated in Fig. 12B, which was added in response to the Examiner's request in the Office Action dated April 23, 2003 ("the April Office Action"). In particular, Fig. 12B shows a right facet having a longer length than a left facet, the left facet having a steeper slope than the right facet. (See Exhibit A, Fig. 12B, annotated for the Examiner's convenience). Although Fig. 12B may look similar to Fig. 12A, each figure is different because the facet configuration is oriented in a different direction. In Fig.

Application No. 09/921,844
Request dated March 26, 2004
Reply to Office Action of January 7, 2004

12A, the facet having a longer length (facet 324) is oriented toward leading end 302. In Fig. 12B, the facet having the longer length is oriented toward side 310'.

Fig. 12B was not present in the drawings when the Examiner made his restriction. Although Fig. 12B was added subsequent to the Restriction Requirement, Applicant submits that the subject matter illustrated in Fig. 12B belongs with Species 3 because both Figs. 12A and 12B illustrate surface projections having an included angle greater than 90 degrees. Accordingly, Applicant respectfully requests the Examiner to rejoin claims 131, 133, 135, 137-145, 205, 206, 213-215, and 272-276.

Alternatively, if the Examiner believes that the subject matter illustrated in Fig. 12B represents another patentably distinct species, Applicant respectfully requests the Examiner to so state on the record.

II. Request for withdrawal of finality

Applicant respectfully submits that the Examiner's rejection was made final prematurely. The MPEP states that a rejection may properly be made final on a second action "except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)." (MPEP § 706.07(a), page 700-73, col. 1 (February 2003)).

In Applicant's reply of October 8, 2003, Applicant amended independent claim 219 and overcame the Examiner's rejection of that claim and its associated dependent claims under 35 U.S.C. 112, second paragraph in the April Office Action. In the present Office Action, the Examiner rejected claim 247, dependent from claim 219, under 35 U.S.C. § 112, second paragraph under different grounds. In doing so, Applicant submits that the Examiner presented a new ground of rejection not necessitated by Applicant's amendment of claim 219. In particular, the portion of claim 247 that the Examiner alleges as being indefinite is completely unrelated to any rejection made in the April Office Action. Accordingly, Applicant respectfully requests the Examiner to withdraw finality of the present Office Action pursuant to MPEP § 706.07(d).

Application No. 09/921,844
Request dated March 26, 2004
Reply to Office Action of January 7, 2004

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1066.

Respectfully submitted,

MARTIN & FERRARO, LLP

Dated: March 26, 2004

By: 

Thomas H. Martin

Registration No. 34,383

1557 Lake O'Pines Street, NE
Hartville, Ohio 44632
Telephone: 330-877-0700
Facsimile: 330-877-2030

Exhibit A

5/9

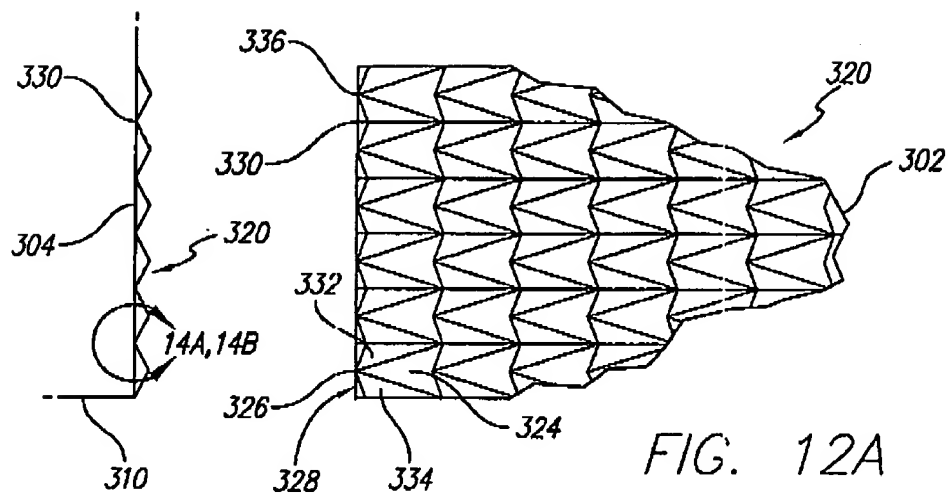


FIG. 12A

FIG. 14

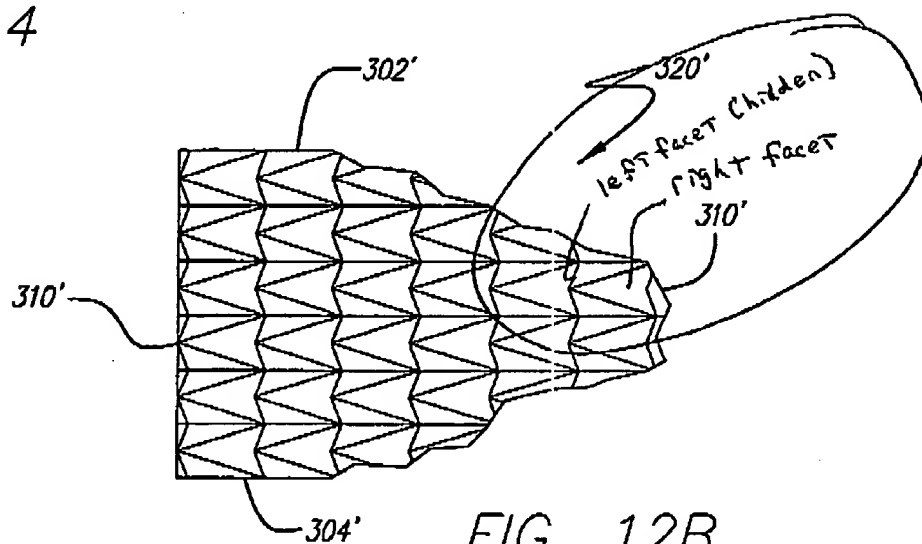


FIG. 12B

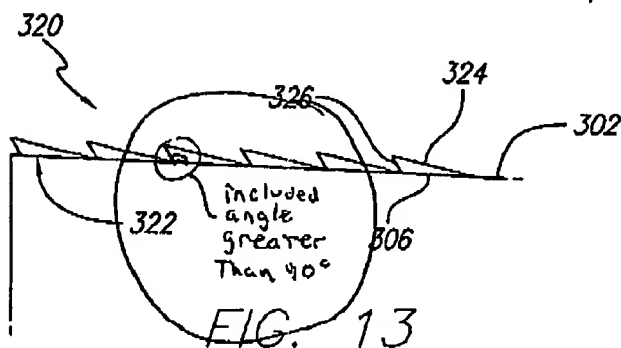


FIG. 13

Exhibit G



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,844	08/03/2001	Gary K. Michelson	101.0084-01000	8295
22882	7590	04/23/2004		
MARTIN & FERRARO, LLP 1557 LAKE OPINES STREET, NE HARTVILLE, OH 44632				
			EXAMINER SNOW, BRUCE EDWARD	
			ART UNIT 3738	PAPER NUMBER

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED

APR 26 2004

MARTIN & FERRARO LLP

Advisory Action

Application No.

09/921,844

Applicant(s)

MICHELSON, GARY K.

Examiner

Bruce E Snow

Art Unit

3738

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 March 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

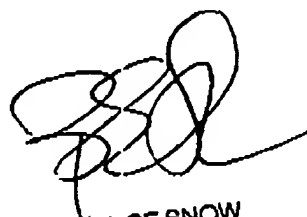
Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No.(s). _____
10. ☐ Other: _____

Continuation Sheet (PTOL-303)

Application No. 09/921,844

Continuation of 5. does NOT place the application in condition for allowance because: One of ordinary skill in the art would not interpret what applicant's specification describes as the "rearward facet 326" as the left facet (according to Exhibit A) or the "forward facet 324" as the right facet. Applicant's amendment necessitated the new grounds of rejection and the Final is proper.



BRUCE SNOW
PRIMARY EXAMINER

Exhibit H

821.01

MANUAL OF PATENT EXAMINING PROCEDURE

821.01 After Election With Traverse

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper, it should be repeated and made final in the next Office action. (See MPEP § 803.01.) In doing so, the examiner should reply to the reasons or arguments advanced by applicant in the traverse. Form paragraph 8.25 should be used to make a restriction requirement final.

¶ 8.25 Answer to Arguments With Traverse

Applicant's election with traverse of [1] in Paper No. [2] is acknowledged. The traversal is on the ground(s) that [3]. This is not found persuasive because [4].

The requirement is still deemed proper and is therefore made FINAL.

Examiner Note:

1. In bracket 1, insert the invention elected.
2. In bracket 3, insert in summary form, the ground(s) on which traversal is based.
3. In bracket 4, insert the reasons why the traversal was not found to be persuasive.

If the examiner, upon reconsideration, is of the opinion that the requirement for restriction is improper, he or she should state in the next Office action that the requirement for restriction is withdrawn and give an action on all the claims.

If the requirement is repeated and made final, in that and in each subsequent action, the claims to the nonelected invention should be treated by using form paragraph 8.05.

¶ 8.05 Claims Stand Withdrawn With Traverse

Claim [1] withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected [2], there being no (allowable) generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. [3].

Examiner Note:

In bracket 2, insert --invention-- or --species--.

This will show that applicant has retained the right to petition from the requirement under 37 CFR 1.144. (See MPEP § 818.03(c).)

When the case is otherwise ready for issue, and has not received a final action, the examiner should treat the case by using form paragraph 8.03. (See MPEP § 809.02(c).)

When preparing a final action in an application where there has been a traversal of a requirement for

restriction, the examiner should indicate in the Office action that a complete reply must include cancellation of the claims drawn to the nonelected invention, or other appropriate action (37 CFR 1.144). See form paragraph 8.24.

¶ 8.24 Reply to Final Must Include Cancellation

This application contains claim [1] drawn to an invention nonelected with traverse in Paper No. [2]. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

Examiner Note:

For use in FINAL rejections of applications containing claims nonelected with traverse.

Where a reply to a final action has otherwise placed the application in condition for allowance, the failure to cancel claims drawn to the nonelected invention or to take appropriate action will be construed as authorization to cancel these claims by examiner's amendment and pass the application to issue after the expiration of the period for reply.

Note that the petition under 37 CFR 1.144 must be filed not later than appeal. This is construed to mean appeal to the Board of Patent Appeals and Interferences. If the application is ready for allowance after appeal and no petition has been filed, the examiner should simply cancel the nonelected claims by examiner's amendment, calling attention to the provisions of 37 CFR 1.144.

821.02 After Election Without Traverse

Where the initial requirement is not traversed, if adhered to, appropriate action should be given on the elected claims. Form paragraphs 8.25.01 or 8.25.02 should be used by the examiner to acknowledge the election without traverse.

¶ 8.25.01 Election Without Traverse

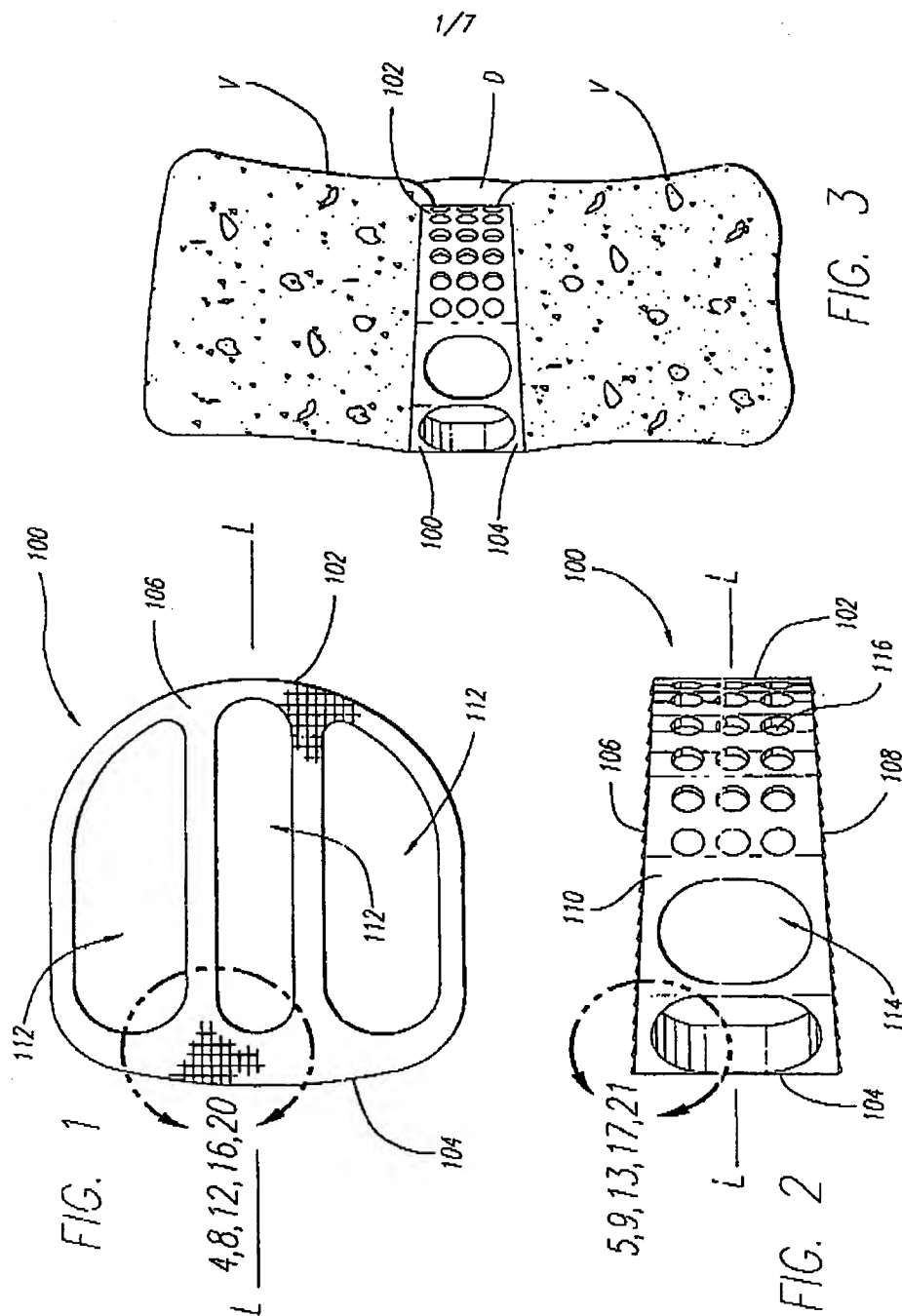
Applicant's election without traverse of [1] in Paper No. [2] is acknowledged.

¶ 8.25.02 Election Without Traverse Based on Incomplete Reply

Applicant's election of [1] in Paper No. [2] is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

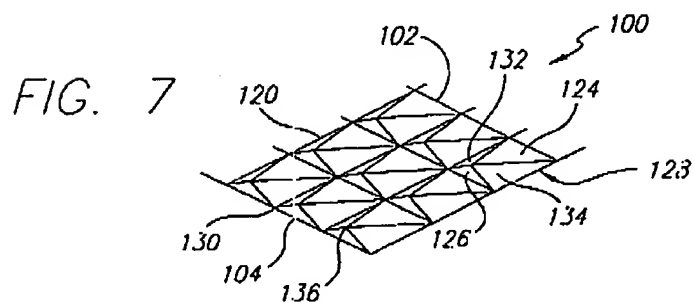
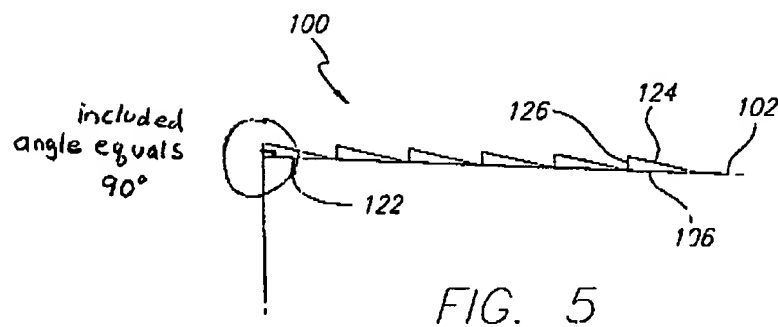
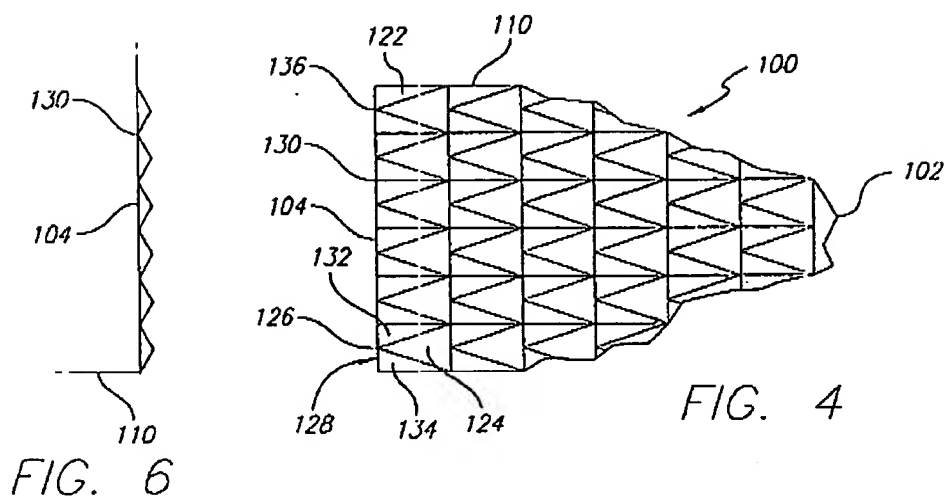
Claims to the nonelected invention should be treated by using form paragraph 8.06.

Exhibit I



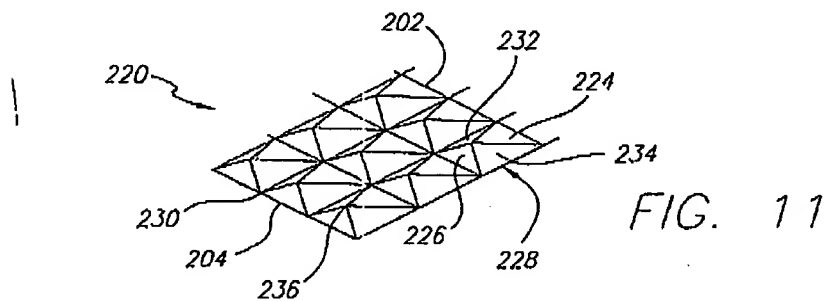
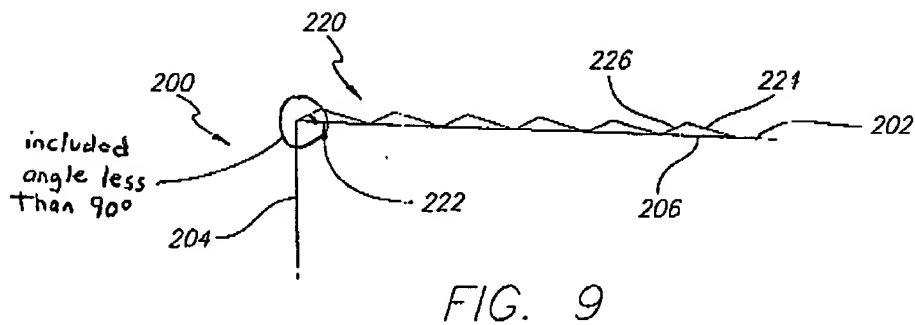
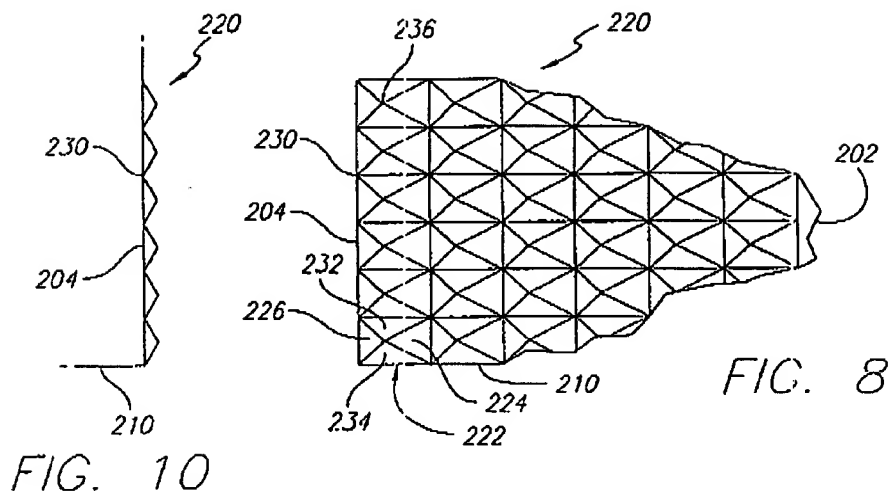
Species 1

2/7



Species 2

3/7



Species 3 (elected embodiment)

4/7

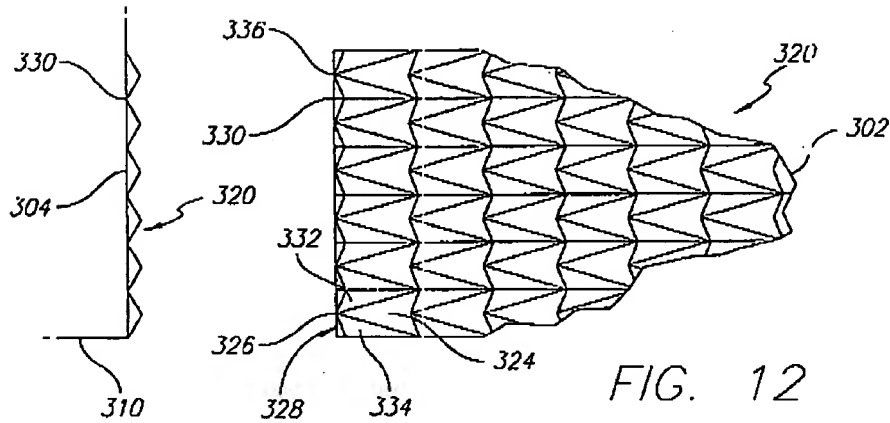
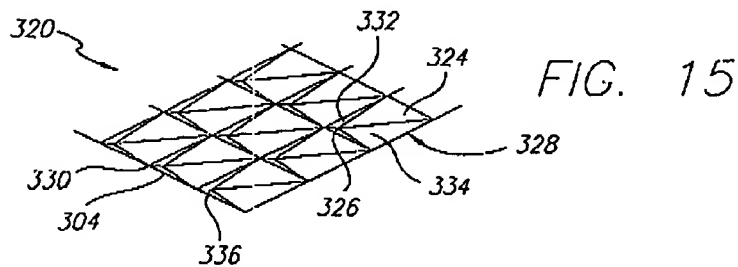
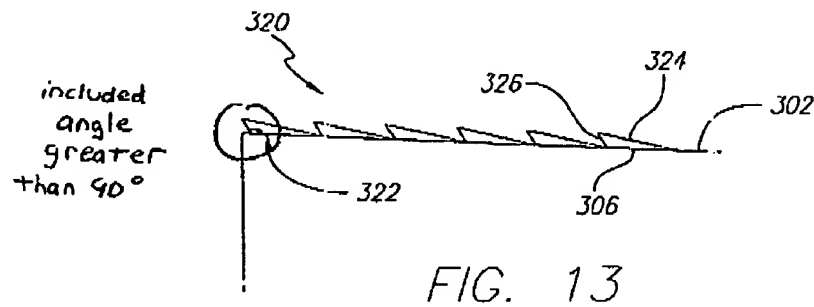
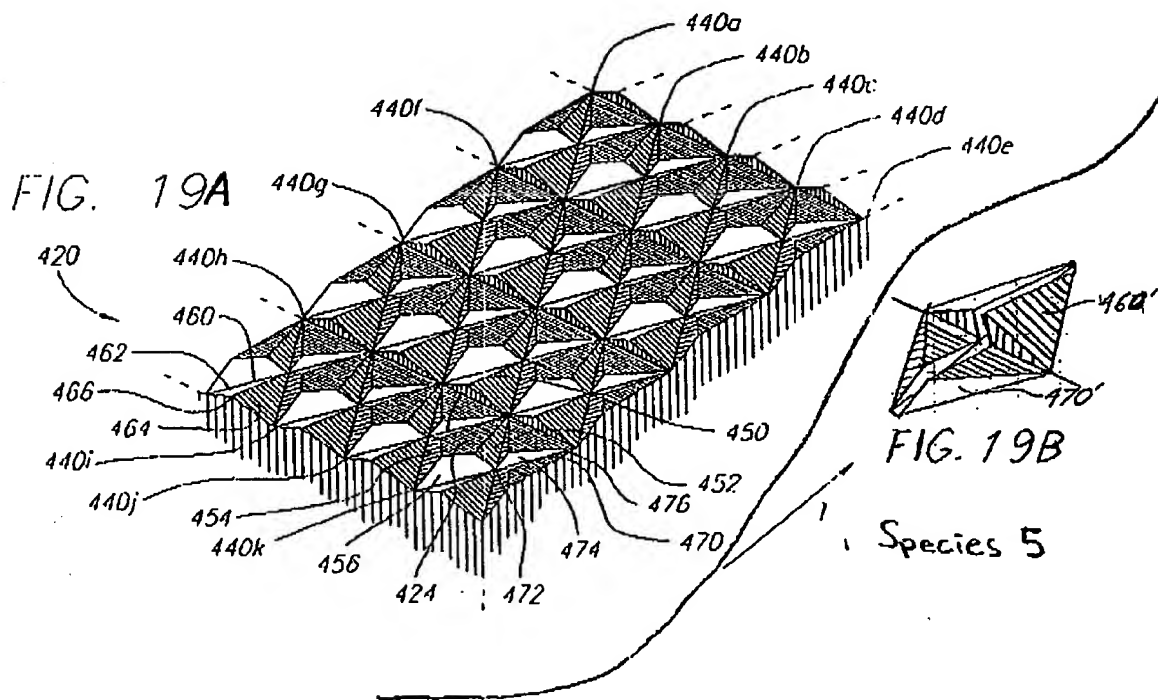
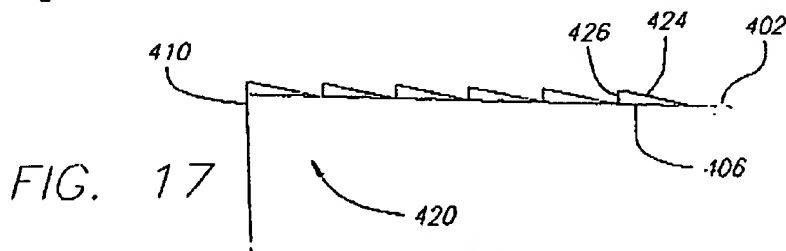
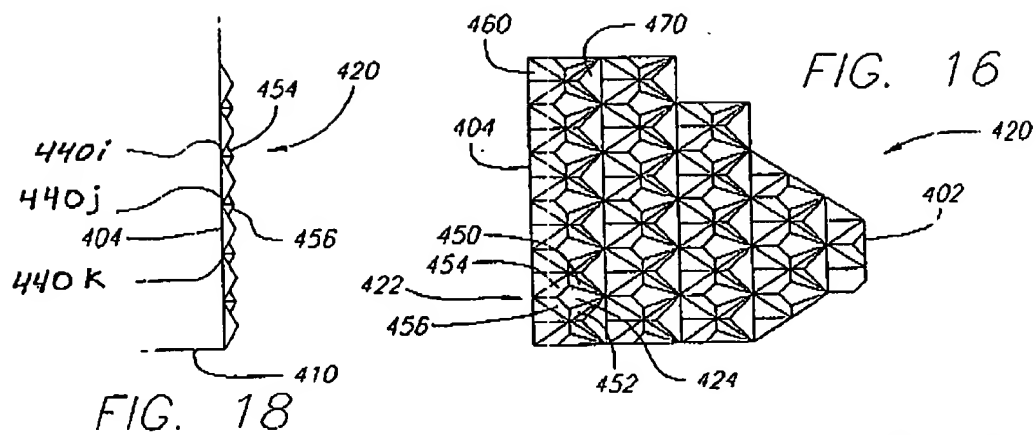


FIG. 14



Species 4

5/7



Species 5

Species 6

6/7

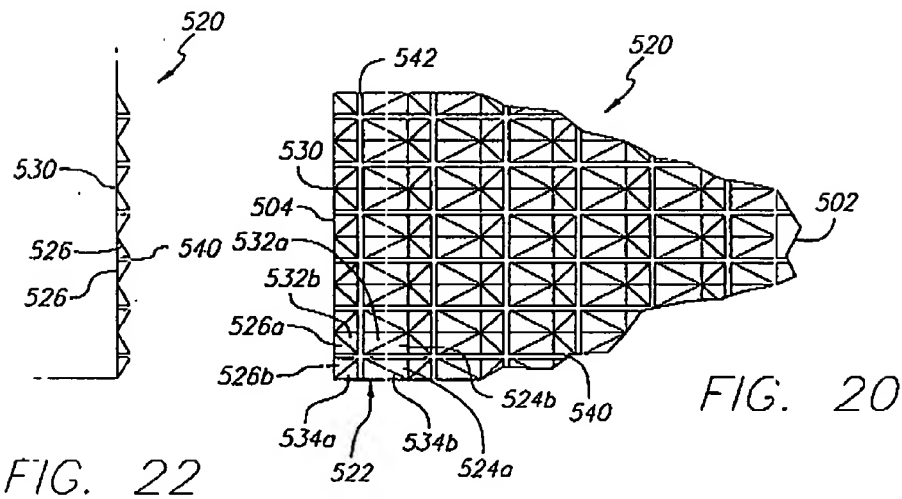


FIG. 22

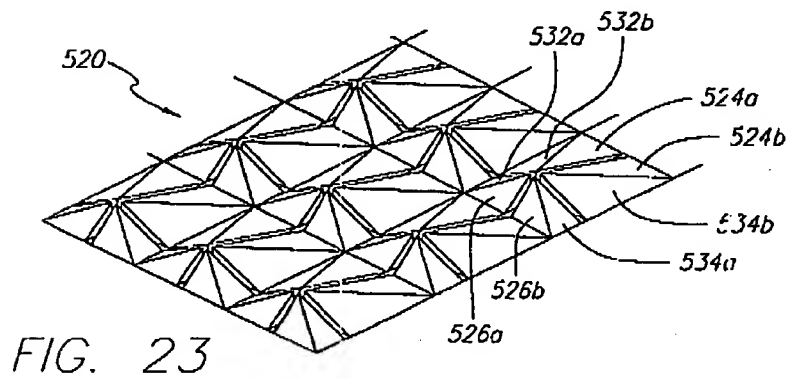
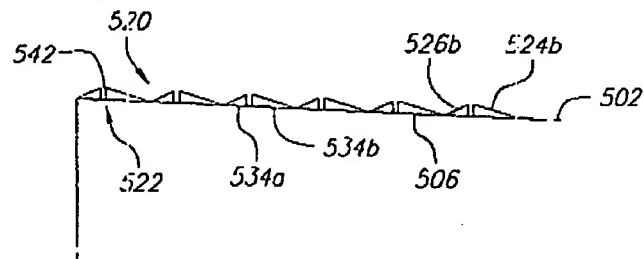


Exhibit J

EXAMINATION OF APPLICATIONS

706.07(a)

706.07(a) Final Rejection, When Proper on Second Action [R-1]

Due to the change in practice as affecting final rejections, older decisions on questions of prematurity of final rejection or admission of subsequent amendments do not necessarily reflect present practice.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). Where information is submitted in an information disclosure statement during the period set forth in 37 CFR 1.97(c) with a fee, the examiner may use the information submitted, e.g., a printed publication or evidence of public use, and make the next Office action final whether or not the claims have been amended, provided that no other new ground of rejection which was not necessitated by amendment to the claims is introduced by the examiner. See MPEP § 609 paragraph (B)(2). Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. Where information is submitted in a reply to a requirement under 37 CFR 1.105, the examiner may NOT make the next Office action relying on that art final unless all instances of the application of such art are necessitated by amendment.

A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings should not be made final if it includes a rejection, on prior art not of record, of any claim amended to include limitations which should reasonably have been expected to be claimed. See MPEP § 904 *et seq.* For example, one would reasonably expect that a rejection under 35 U.S.C. 112 for the

reason of incompleteness would be replied to by an amendment supplying the omitted element.

>A second or any subsequent action on the merits in any application or patent involved in reexamination proceedings may not be made final if it contains a new ground of rejection necessitated by the amendments to 35 U.S.C. 102(e) by the Intellectual Property and High Technology Technical Amendments Act of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)), unless the new ground of rejection was necessitated by an amendment to the claims or as a result of information submitted in an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).<

When applying any 35 U.S.C. 102(e)/103 references against the claims of an application filed on or after November 29, 1999, the examiner should anticipate that a statement averring common ownership at the time the invention was made may disqualify any patent or application applied in a rejection under 35 U.S.C. 103 based on 35 U.S.C. 102(e). If such a statement is filed in reply to the 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made. See MPEP § 706.02(I)(3).

See MPEP § 809.02(a) for actions which indicate generic claims as not allowable.

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the examiner should be on guard not to allow such claims. See MPEP § 714.04. The claims may be finally rejected if, in the opinion of the examiner, they are clearly open to rejection on grounds of record.

Form paragraph 7.40 should be used where an action is made final including new grounds of rejection necessitated by applicant's amendment.

¶ 7.40 Action Is Final, Necessitated by Amendment

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

706.07(b)

MANUAL OF PATENT EXAMINING PROCEDURE

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. This form paragraph should not be used in reissue litigation cases (SSP- 1 month) or in reexamination proceedings (SSP- 1 or 2 months).
2. 37 CFR 1.136(a) should not be available in a reissue litigation case and is not available in reexamination proceedings.

¶ 7.40.01 Action Is Final, Necessitated by IDS With Fee

Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on [1] prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. This form paragraph should not be used and a final rejection is improper where there is another new ground of rejection introduced by the examiner which was not necessitated by amendment to the claims.
2. In bracket 1, insert the filing date of the information disclosure statement containing the identification of the item of information used in the new ground of rejection.

706.07(b) Final Rejection, When Proper on First Action [R-1]

The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application.

>A first Office action in a continuing or substitute application may not be made final if it contains a new ground of rejection necessitated by the amendments to 35 U.S.C. 102(e) by the Intellectual Property and

High Technology Technical Amendments of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)).<

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.

Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application.

A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted.

A first action final rejection should be made by using Form Paragraphs 7.41 or 7.41.03, as appropriate.

¶ 7.41 Action Is Final, First Action

This is a [1] of applicant's earlier Application No. [2]. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Note:

1. In bracket 1, insert either --continuation-- or --substitute--, as appropriate.
2. If an amendment was refused entry in the parent case on the grounds that it raised new issues or new matter, this form paragraph cannot be used. See MPEP § 706.07(b).
3. This form paragraph should not be used in reissue litigation cases (SSP- 1 month) or in reexamination proceedings (SSP-1 or 2 months).
4. 37 CFR 1.136(a) should not be available in a reissue litigation case and is not available in reexamination proceedings.